

# Notice of Allowability

## Application No.

10/597,059

## Examiner

CHUKWUMA O. NWAONICHA

## Applicant(s)

GREB ET AL

## Art Unit

1621

### - The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 26 May 2008.
2. ☒ The allowed claim(s) is/are 14-19, 20-24, and 26-28 (now renumbered 1-13, respectively).
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of the:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.  
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached  
1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.  
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.  
**Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date 06/26/2008.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

### **39DETAILED ACTION**

#### **Current Status**

1. This action is responsive to Applicants' amendment of 26 May 2008.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Claims 14-19, 20-24, and 26-28 are pending in the application.
4. The 112 rejection has been withdrawn following Applicants amendments.

***This application is a 371 of PCT/DE05/00095 01/24/2005***

#### ***Examiner's Amendment***

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Gudrun Huckett on 6/26/2008.

The Application has been amended as follows:

In claims 14, pages 3, lines 1 and 2 delete "as well as their physiologically compatible derivatives, in particular salts and trimethyl silyl derivatives" and insert - as well as its physiologically compatible salts and trimethyl silyl compounds -.

In claims 22, line 1; delete the word "liposomal".

In claims 23, line 1; delete the word "liposomal".

In claims 24, line 1; delete the word "liposomal".

In claims 26, line 1; delete the word "liposomal".

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In claims 28, line 1; delete the word "liposomal".

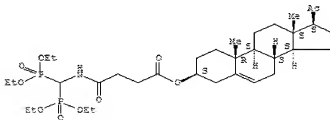
### Allowed Claims

Claims 14-19, 20-24, and 26-28 are allowable over the prior art of record.

### Reason For Allowance

The following is an examiner's statement of reasons for allowance: A search of the prior art failed to uncover any reference that anticipates or renders obvious a bisphosphonic acid of the general formula I, a method of preparing the same, its composition and a method of making the composition; wherein all the variables are as defined in the claims.

The closest prior art is Ueno et al., {US 5,391,776}. Ueno et al. teach the bisphosphonic compound shown below. The bisphosphonic compound taught by Ueno et al. differs from the bisphosphonic acid of the general formula I in that Ueno et al. bisphosphonic compound is substituted with ester and Ac groups while Applicants claim bisphosphonic acid compound substituted with alkyl and ether groups. These differences are not readily apparent and would not have been suggested to one of ordinary skill.



**Claims 14-19, 20-24, and 26-28 are allowed.**

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne (Bonnie) Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/YVONNE L. EYLER/  
Supervisory Patent Examiner, Art Unit 1621

/Chukwuma O. Nwaonicha/  
Examiner, Art Unit 1621